



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/668,892

09/23/2003

Joel W. Benson

9763/8

3581

7590

01/03/2006

Joel W. Benson  
BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, IL 60610

EXAMINER

BATHINI JR, LEON M

ART UNIT

PAPER NUMBER

2857

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/668,892	Applicant(s) BENSON ET AL.	
	Examiner Leon M. Bathini Jr.	Art Unit 2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 72 and 76-98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 72 and 76-98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/23/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/23/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 72-78, 80-86, and 88-96** are rejected under 35 U.S.C. 102(b) as being anticipated by Thies et al. (U.S. Patent Number 5,206,804).

With respect to **claims 72-78**, Thies et al. teach the following:

-a method for selecting shoes by obtaining the size dimensions of the feet of a plurality of people (col. 2, lines 54-60);

- a method for identifying the shoes purchased by said plurality of people (col. 3, lines 66-70; col.4, lines 1-18; and col. 5, lines 50-58);

- a method for creating a database that includes information concerning the foot shape or dimensions and correlated manufacturer's sizes for, and the sizes selected by said plurality of people (col. 2, lines 63-65 and col.3, lines 13-14);

- a method for selecting shoes for a particular person based at least in part upon the information of said database (col. 9, lines 59-63).

- a method including the step of associating the foot shape, dimensions, and manufacturer's sizes for shoes selected by each particular person with a unique identifier associated with that person (col. 9, lines 13-31).

- a method including the step of using said unique identifier to access a profile of foot shape, dimensions, manufacturer's sizes and selected shoes for the associated person

whenever required to obtain shoes for said person or to assist in selecting shoes for another person (col. 9, lines 13-31).

- a method including the step of selecting shoes for one person, based upon satisfactory shoe selections of another person having a similar foot shape, dimensions, manufacturer's sizes or other characteristics (col. 9, lines 13-31 and col. 10 lines 13-19).

With respect to **claims 80-86**, Thies et al. teach the following:

- a method including the step of accessing said database to determine satisfactory shoe fits for a particular person, to enable a gift of properly fitting shoes for that person (col.9, lines 18-19 and 62-63; col. 10, lines 2-12).

- a method including the steps of using said database to keep track of an inventory of shoes; and replenishing said inventory based upon the shoe purchases of customers detected from said database (col. 5, lines 50-58).

- a method including the step of using said database to increase the efficiency and reduce the cost of selling properly fitting shoes (col. 1, lines 17-19, 44-52; col. 4, lines 5-10).

- a method including the step of using the information of said database to predict patterns of buying for shoes having specified characteristics (col. 3, lines 66-68; col. 4, lines 1-18).

- a method including the step of using the information of said database to make recommendations to customers regarding shoes that may be satisfactory for those customers (col. 10, lines 28-34).

- a method for selecting shoes, comprising the steps of determining the size and shape of a particular person's feet (col. 2, lines 54-60); providing a database of stored information designating shoe selections for various sizes and shapes of people's feet (col.2, lines 63-65;

Art Unit: 2857

col. 3, lines 13-14); automatically selecting shoes from said database that will accommodate the size and shape of said particular person's feet (col. 1, lines 63-68; col. 2, lines 1-9; col. 10, lines 28-34); and selecting and obtaining shoes that accommodate the size and shape of that particular person's feet (col. 9, lines 59-63).

-a method that includes using an apparatus to detect the shape and size of said person's feet (col. 2, lines 54-58).

With respect to **claims 88-96**, Thies et al. teach the following:

- a method of determining comprises including information regarding the size and shape of said particular person's feet in said database and reading the size and shape of said particular person's feet from said database (col. 2, lines 63-68; col. 3, lines 1-3).

- a method including the step of defining criteria for selecting only specified types of shoes and using said criteria to select from said database only shoes that satisfy said criteria and accommodate the size and shape of said particular person's feet (col. 9, lines 24-46; col. 10, lines 28-33).

- a method including obtaining said criteria for a particular person from said database (col. 10, lines 7-12; col. 9, line 18-20).

- a method including the step of accessing said database over the Internet (col. 3, lines 15-17).

- a method of selecting shoes includes the step of accessing said database to determine the shoes that will accommodate the size and shape of said particular person's feet and that are available in inventory (col. 10, lines 28-58).

- a method including the step of automatically subtracting from the inventory of said database all shoes that are obtained by said particular person (col. 10, lines 33-38).

- a method of selecting includes the step of identifying from said database the shoes selected by other people to accommodate their foot sizes and shapes that are similar to the particular person's foot size and shape', and automatically proposing said shoes for consideration by said particular person to fit his own feet (col. 10, lines 2-4 and 28-34).

- a method for determining the size and shape of said selected portion of the human body for a particular person (col. 2, lines 54-60); providing a database of stored information designating selections of said things that will fit various sizes and shapes of said selected portion of the human body (col. 2, lines 63-65); automatically selecting things from said database that will accommodate the size and shape of said selected portion of the body of the particular person (col. 10, lines 28-34; col. 1, lines 63-68; col. 2, lines 1-9); selecting and obtaining the things that accommodate the size and shape of the selected portion of that person's body (col. 9, lines 59-63).

- a method wherein the selected portion of the body is a foot and the manufactured thing is a shoe (col. 2, lines 47-63).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 79** is rejected under 35 U.S.C. 103(a) as being unpatentable over Thies et al. in view of Joseph (U.S. Patent Number 5,878,401) .

With respect to the above claims, Thies et al teach all the features of the claimed invention except that Thies et al. do not teach the elements in **claim 79**.

However, Joseph teaches a method including the step of determining satisfaction with shoes, by using a database to note whether the shoes were retained or returned after purchase (col. 7, lines 8-11) by comparing the TIME SOLD with the TIME RETURNED.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the footwear cataloging and sizing method of Thies et al. to include in the database a method that determines if shoes were retained or returned after purchase as taught by Joseph, because it helps the buyer keep an updated record on his/her business inventory

5. **Claim 97** is rejected under 35 U.S.C. 103(a) as being unpatentable over Thies et al. in view of Yoda (U.S. Patent Number 5,515,268) .

With respect to the above claims, Thies et al teach all the features of the claimed invention except that Thies et al. do not teach the elements in **claim 97**.

However, Yoda teaches a method wherein the selected portion of the body is a hand and the manufactured thing is a glove (col. 4, lines 8-22). Yoda does not specifically mention the parts of the body that are scanned, but he is referring to the whole body that may be scanned into the database.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the footwear cataloging and sizing of Thies et al. to also include a cataloging and sizing method for a glove as taught by Joseph, because it increases the number of products that a person can buy online.

6. **Claims 87 and 98** is rejected under 35 U.S.C. 103(a) as being unpatentable over Thies et al. in view of Rolloff et al. (U.S. Patent Number 5,640,779) .

With respect to the above claims, Thies et al teach all the features of the claimed invention except that Thies et al. do not teach the elements in **claims 87 and 98**.

However, Rolloff et al. teach a method that includes using an apparatus that presses sensing pins against said particular person's feet and thereby determines the shape and size of that person's feet (col. 7, lines 17-19); and a method wherein said step of determining includes using an apparatus that presses sensing pins against the selected portion of the body of said particular person and thereby determines the shape and size of the selected portion of that person's body (col. 7, lines 17-19).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the footwear cataloging and sizing of Thies et al. to include sensing pins that determines the size and shape of a selected portion of the body as taught by Rolloff et al., because the sensing pins can determine the surface contour of a selected portion of the body in a relatively inexpensive and reliable way.

#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leon M. Bathini Jr. whose telephone number is 571-272-7129. The Examiner can normally be reached on 8:30AM-5:00PM.

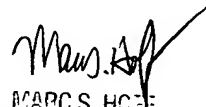
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marc Hoff can be reached on 571-272-2216. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2857

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LBJ

  
MARC S. HOFF  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800